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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,191	07/21/2003	Kenneth J. Micklash II	36-000101US	7717
29490	7590	09/11/2007		
GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION 10675 JOHN JAY HOPKINS DRIVE, SUITE E225 SAN DIEGO, CA 92121-1127			EXAMINER LEVKOVICH, NATALIA A	
			ART UNIT 1743	PAPER NUMBER
			NOTIFICATION DATE 09/11/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPLegal@gnf.org  
jclarke@gnf.org

## Office Action Summary

Application No.

10/624,191

Applicant(s)

MICKLASH ET AL.

Examiner

Natalia Levkovich

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14, 16-29, 31-33, 35, 37-39, 72-83 and 85-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 10-14, 16-29, 31-33, 35, 37-39, 72-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-8,10-14,16-29,31-33,35,37-39,72-83 and 85-93.

## **DETAILED ACTION**

### ***Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 06/29/2007 has been entered.

### **Election/Restrictions**

2. Claims 1-8,10-14,16-29,31-33,35 and 37-39, as amended, are directed to an invention that is independent and patentably distinct from the invention originally claimed for the following reasons:

Original claims 1-39 (Species I) were drawn to a parallel reaction device comprised of a reaction block engaged with top and bottom lids, the top lid having protrusions for pressing a top gasket against inlets of the reaction wells;

Art Unit: 1743

The amended claims 1-8,10-14,16-29,31-33,35 and 37-39 (Species II) are directed to a parallel reaction device comprised of a reaction block with recessed regions, a band, a bottom lid and a top lid without protrusions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 1-8,10-14,16-29,31-33,35 and 37-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the protruding annular ridges around the apertures of the top lid, as well as the band having a pair of top and bottom hinges and a pair of top and bottom latches, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate

Art Unit: 1743

figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 86-88 and 91-93 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 86 recites each hinge component independently comprising a male or female lift-off hinge component. It is not clear how the band would get engaged with the lids in case when all the components are either only male or only female ones. Also see claim 87 with respect to the latch bodies / keeper plates.

Art Unit: 1743

Claim 91 recites through holes in the top lid arranged such as to 'axially align' with reaction wells of the reaction block. This limitation is unclear and indefinite, since the reaction block is not positively claimed as a part of the instant invention, and the well arrangement remains unspecified.

In claim 93, 'the aperture', lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 85-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield et al. (US 6054100) in view of Sanadi (US 5516490).

Art Unit: 1743

As was previously discussed, Stanchfield discloses a multi-well synthesis apparatus comprising, as shown in Figure 8, a reaction block 312, an upper cover 314 ['top lid' – Ex.], a lower cover 316 ['bottom lid' – Ex.], and a pair of collars 374, 376 forming a 'band'. The lids and the 'band' include latches 366, 368 and 388, 396, respectively.

Stanchfield does not teach the lids and the band to include hinges. However, latches, hinges, clips and the like are well recognized equivalents routinely used in the art. For example, Sanadi discloses multi-well assemblies comprising reaction blocks engaged with lids "through the use of one or more clamps such as a snap, hinge, sliding catch, or even a hook" (Col.6, lines 7-10"). . It would have been obvious to one of ordinary skill in the art at the time the invention was made to have arranged additional attachments means, such as hinges on the lids and the band in the modified assembly of Stanchfield, in order to provide more stability for the assembly.

With respect to claim 89, as was discussed in the prior Office Action, Stanchfield does not teach the top lid to include protrusions for engaging the reaction block. Sanadi discloses in Figure 14 an embodiment comprising lid 286 which has projections, or annular collars 284. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed such protrusions in the lid of the modified assembly of Stanchfield, in order to reduce cross-contamination.

Regarding claim 91, Figure 1 of Stanchfield shows top lid 14 having an array of apertures 70.



Art Unit: 1743

As to claim 93, although Stanchfield does not teach the 'annular ridges' protruding around the apertures, these elements are well known. For example, Figure 2 of Sanadi shows annular ridges 64 disposed around the apertures. It would have been clearly within the ordinary skill in an artisan at the time the invention was made to have arranged such ridges around the apertures in the lid of the modified assembly of Stanchfield, in order to reduce cross-contamination.

### ***Response to Arguments***

9. Applicant's arguments dated 06/29/2007 have been fully considered but they are not persuasive.

Applicant argues that 'Stanchfield and Sanadi, whether considered individually or in combination, fail to teach or suggest the claimed device that includes a band and lids each having corresponding hinge and latch components that are configured to engage one another'. Examiner disagrees. Stanchfield teaches a top lid, a bottom lid and a 'band' each including corresponding latches. See the discussion above. It would have been also obvious to one of ordinary skill in the art at the time the invention was made to have arranged corresponding hinges on the lids and the band in the modified assembly of Stanchfield, in order to provide additional attachment means for the assembly.

It is noted that Applicant repeatedly refers on various occasions to the interview conducted on June 14, 2007. For example, Applicant states that the

Art Unit: 1743

Examiner 'agreed to consider the claims as amended herein'. Examiner notes that the interview was focused on §112 issues of the claims filed on 10/20/2006. The latest amendments were presented after the interview, namely, on 06/29/2007.

### ***Conclusion***

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1743

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700